



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

D. Rich Lang

Filed: January 31, 2001

Serial No: 09/773,343

For: AVIATION CHECKLIST AND
METHOD OF ADVERTISING WHICH
INCORPORATES AN AVIATION
CHECKLIST

Atty. Ref. No.: 44PA0300

Examiner: Willmon Fridie, Jr.
Group Art Unit: 3722

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TECHNOLOGY CENTER R3700

Assistant Commissioner for Patents
Box RESPONSES
Group Art Unit 3722
Washington, D.C. 20231

Dear Sir or Madam:

EXPRESS MAIL CERTIFICATE

"Express Mail" Label Number EU756864837 US

Date: Nov. 21, 2002

I hereby certify that the enclosed "Applicant's Response to Second Office Action, including marked-up and clean versions of Amended Claims, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box RESPONSES, Group Art Unit 3722, Washington, D.C. 20231.

Robert R. Waters
(Typed or printed name of person mailing paper or fee)

(Signature of person mailing paper or fee)

NOV 21 2002

PTO/SB/17 (10-02)

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37225

FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**460.00**

Complete if Known

Application Number	09/773,343
Filing Date	January 31, 2001
First Named Inventor	Lang
Examiner Name	Fridie
Art Unit	3722
Attorney Docket No.	44PA0300

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number:
Deposit Account Name:
The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION (continued)

NOV 26 2002

TECHNOLOGY CENTER B3700

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	400	2252	200	Extension for reply within second month	
1253	920	2253	460	Extension for reply within third month	460
1254	1,440	2254	720	Extension for reply within fourth month	
1255	1,960	2255	980	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,280	2453	640	Petition to revive - unintentional	
1501	1,280	2501	640	Utility issue fee (or reissue)	
1502	460	2502	230	Design issue fee	
1503	620	2503	310	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	740	2809	370	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	740	2810	370	For each additional invention to be examined (37 CFR 1.129(b))	
1801	740	2801	370	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**460**

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	740	2001	370	Utility filing fee	
1002	330	2002	165	Design filing fee	
1003	510	2003	255	Plant filing fee	
1004	740	2004	370	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Extra Claims Fee from below Fee Paid

Total Claims -20** = X =

Independent Claims -3** = X =

Multiple Dependent =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	84	2201	42	Independent claims in excess of 3	
1203	280	2203	140	Multiple dependent claim, if not paid	
1204	84	2204	42	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

SUBMITTED BY

Name (Print/Type)	Robert R. Waters	Registration No. (Attorney/Agent)	43,241	Telephone	304-522-6658
Signature	<i>Robert R. Waters</i>	Date	Nov. 21, 2002		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

R. Kent
12/2/02
#8/B

In re. Patent Application of:

D. Rich Lang

Filed: January 31, 2001

Serial No: 09/773,343 ✓

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Dear Sir or Madam:

APPLICANT'S RESPONSE TO
SECOND OFFICE ACTION

In response to the Office Action dated May 21, 2002, the Applicant hereby provides the following Response:

1) The Examiner has rejected Claims 1 - 16 under 35 U.S.C § 103 as being unpatentable over Esslinger, Jr. The Examiner further concluded that the claimed indicia is not functionally related to the substrate such as to provide distinction from the prior art to support patentability, as required by *In re Gulack* 217 USPQ 401 (CAFC 1983).

In response, the Applicant has amended Claim 1 to include the requirement of a tabbed index located on the edge opposite the binding means for the printed notebook. The tabbed edge is achieved by sizing the pages of the printed notebook such that each respective page or group of

pages is slightly longer than the previous page or group. For illustration purposes, we note that each tabbed page could be, for example, one-fourth inch longer than the preceding page. The location of the tabbed edges will facilitate ease of operation for the checklist in that it will be easier to locate types of information quickly from looking at the tabbed index.

The Applicant notes that the tabbed index is not disclosed, claimed or inferred by Esslinger, Jr. In fact, a tabbed edge would have no value in the type of instrument claimed by Esslinger, Jr. as it is certainly not necessary or useful to set forth a means for quickly moving from page to page or section to section in a calendar.

Given the new requirement set forth in Element d of Claim 1, Claim 1 is patentably distinguishable over Esslinger, Jr. such as to support patentability. In addition, for the same reasons, dependent Claims 2-9 are likewise patentably distinct over Esslinger, Jr. The Applicant respectfully requests approval of Claims 1-8 as modified.

Concerning method claims 9-16, the Applicant respectfully traverses the Examiner's rejection by noting that Claims 9-16 are method claims directed to a method for delivery of an advertising message. Accordingly, since the article of manufacture (Aviation Checklist) is not being claimed, but rather a method for conducting advertising, the printed indicia rejection is not applicable. As the Court set forth in *Gulack*, the PTO does not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. However, *Gulack* as well as more recent cases also applying the printed matter rejection apply only in situations in which the substrate itself is part of the claimed subject matter.

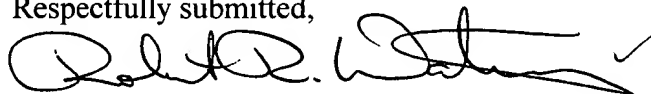
A printed matter rejection has no applicability to a business method claim such as Claims 9-16 for a method of delivering an advertising message. Furthermore, the Federal Circuit has

been hesitant to extend the printed matter rejection doctrine beyond the specific constructions of *Gulack* and others wherein an article of manufacture with printed indicia is claimed. The Court has noted in *Gulack* and other cases that "a printed matter rejection under §103 stands on questionable legal and logical footing." *In re. Edward S. Lowry*, 32 F.3D 1579 (Fed. Cir. 1994).

In view of the printed indicia rejection, Claims 9-16 were rejected by the Examiner as being unpatentable over Esslinger, Jr. Given that the printed matter rejection is inapplicable, Claims 9-16 of the present application are patentable over Esslinger, Jr. as the reference is directed to a calendar construction article with recipes and other printed information thereupon. Esslinger, Jr. is not directed to a business method for conducting advertising on an aviation checklist. Neither Esslinger, Jr. nor any other reference is directed to a method for advertising to operators of aircrafts wherein said advertising is conducted through the business method of providing advertising space on a required aviation checklist. Accordingly, the Applicant respectfully requests withdrawal of the rejection of Claims 9-16.

Having responded appropriately and in full to the Office Action, the Applicant respectfully requests allowance of the claims and advancement of the application to the Issue Branch. In keeping with patent office requirements, a clean version and marked up version of the modified claims are enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert R. Waters", followed by a checkmark.

ROBERT R. WATERS, #43,241
Counsel for Applicant
D. Rich Lang

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